

REMARKS

Under the Background

This Amendment is being filed with a Request for Continued Examination (RCE). A Final Office Action dated September 20, 2004 was issued in the above-identified application. Claims 1-31, 33-61 and 63-84 are pending in this application. Claims 1, 11, 23, 36, 49, 63, 73 and 74 are independent.

In the Final Office Action all pending claims were rejected under 35 USC § 103. Independent claims 1, 11, 23, 36, 49, 63, 73 and 74 stand rejected under 35 USC § 103 as being unpatentable over Shelton et al. (U.S. Patent 5,954,798 in view of Craig (U.S. Patent 6,654,785). Various dependent claims stand rejected under 35 USC § 103 as being unpatentable over Shelton in view of Craig, in combination with either Lee et al. (Publication No. US 2002/0035603A1) and/or Bauer (Publication No. US 2002/0083134). The Remarks below are directed to the allowability of the aforementioned independent claims with respect to the combination of Shelton and Craig, and thus without conceding the correctness of the applicability of Lee or Bauer to the instant claims, the dependent claims are not separately argued, since the grounds for allowability are the same with respect to the independent claims and dependent claims depending therefrom.

In the Final Office Action, the Examiner bases the rejection of the independent claims on the fact that the Craig reference allegedly provides a missing element recited in each independent claim, namely “wherein the first script and the first control and the second script and the second control are independent from web pages that are displayed on the first computer and the second

computer". The Examiner cites portions of the Craig disclosure for providing the alleged teaching of the missing element. The Examiner bases the obviousness rejection on the alleged fact that "it would have been obvious to one of ordinary skill in the art to modify Shelton by downloading scripts and controls separately from the web page in order to synchronize the communication of URLs, that identifies slide locations to an instructor applet and one or more student applet so instructor applet and one or more student applets in timely and efficient manner". Prior to further discussion of the Craig reference *per se*, the following legal background is provided.

In the first instance, there is no teaching or suggestion in the references to make the hypothetical combination proposed by the Examiner, and thus the combination is improper. *See C.R. Bard Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 48 USPQ2d 1225 (Fed. Cir. 1998) ("the legal conclusion of obviousness requires that there be some suggestion, motivation or teaching in the prior art whereby the person of ordinary skill would have selected the components that the inventor selected and used them to make the new device"). Applicants further respectfully traverse the cited hypothetical combination of references on grounds that the proposed combination involves impermissible hindsight reconstruction of the invention, involving "picking and choosing" from the teachings of multiple references. "Care must be taken to avoid hindsight reconstruction by using the application as a guide through the maze of prior art references combining the right references in the right way so as to achieve the result of the claims in suit." *Grain Processing Corp. v. American Maize-Products Co.*, 840 F.2d 902, 907 (Fed. Cir. 1988). Moreover, regarding hindsight reconstruction, the Federal Circuit has stated that, "virtually all [inventions] are combinations of old elements. Therefore, an Examiner [or accused infringer] may often find

every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue.

Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an Examiner [or accused infringer] to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention.” *Yamanouchi Pharmaceutical v. Danbury Pharmacal*, 231 F.3d 1339, 1343 (Fed. Cir. 2000) citing *In re Rouffet*, 149 F.3d 1350, 1357-58 (Fed. Cir. 1998).

A claim may be rendered obvious under 35 U.S.C. § 103 by combining the teachings of more than one reference in the presence of a teaching, suggestion or incentive supporting the combination. *See e.g. Carella v. Starlight Archery*, 804 F.2d 135 (Fed. Cir. 1986). The mere fact that references can be combined or modified does not render the resulting combination obvious unless the prior art also suggests the desirability of the combination. *See* MPEP § 2143.01, citing *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990). Further, even if the cited references relied upon by the Examiner do in fact teach the individual components of the rejected claims, (a fact that is in no way conceded in the present instance), that fact alone is also not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teaching of the references. Thus, the Examiner can satisfy this burden “only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Lee*, 277 F.3d 1338, 1343, citing *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir. based 1992). As *In re Lee* requires, as does *In re Zurko*, 258 F.3d 1379, 1383-86, the Examiner must set forth with specificity where the motivation exists in the cited references, or, if the Examiner is relying on

general knowledge of the art, that general knowledge must be capable of readily documented substantiation. If the Examiner is relying on well-known facts or common knowledge in the art to provide the motivation, such facts and knowledge must be of a nature that are “capable of instant and unquestionable demonstration as being well-known.” MPEP § 2144.03.A., citing *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970) (requiring that the notice of facts beyond the record which may be taken by the Examiner must be capable of instant and unquestionable demonstration so as to defy dispute).

The Applicants’ invention may not be used as the hindsight roadmap with which the Examiner winds his way through the prior art for identifying features and then, using the teachings of the claimed invention, “use that which the inventor has taught against its teacher” to provide the missing motivation to combine the references to yield the claimed invention. *In re Lee*, 277 F.3d 1338, 1344, citing *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1993). As the Federal Circuit stated in *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999);

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. *See e.g.*, *C.R. Bard, Inc. v. M3 Sys.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998) (describing “teaching or suggestion or motivation [to combine]” as an “essential evidentiary component of an obviousness holding”); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (“the Board must identify specifically...the reasons one of ordinary skill in the art would have been motivated to select the references and combine them”); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (examiner can satisfy burden of obviousness in light of combination “only by showing some objective teaching [leading to the combination]”); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1998) (evidence of teaching or suggestion

“essential” to avoid hindsight)...Combining prior art references without evidence of such a suggestion, teaching or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight. See e.g., *Interconnect Planning Corp., v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985) (“The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.”)

Thus, in accordance with the legal basis set forth above, in order for an obviousness rejection to stand there must be a teaching or suggestion in the references themselves to make the combination made by the Examiner, and, importantly, the combination, even if proper, must when made, recite each and every limitation of the claims being rejected. It is respectfully submitted that the neither the Shelton nor the Craig reference provides any motivation for combining these references, nor does the Craig reference recite, teach or suggest the element admittedly missing from Shelton. Thus, even if the Examiner’s combination of Shelton and Craig were proper, which it is respectfully submitted such combination is not, such combination would not yield that the claimed invention as the Craig reference fails to provide the element which the Examiner has admitted is missing from Shelton.

Turning specifically to the Craig reference, Craig teaches a computerized system for providing slide presentations to students over a network, the slide presentations being led by an instructor. The Craig reference teaches the provision of an instructor applet to be run on the instructor computer, and a student applet to be run on the student computer. The system relies upon the presence of a predetermined list of the slides which are contained in an individual presentation to be made by the instructor. This list must be present on the student computer and the instructor computer. When an instructor changes the slide to be viewed during an instruction

session, the instructor applet instructs a synchronization server, which is independent of the instructor computer and the student computer. The synchronization server sends an instruction to the student applet to obtain the next slide on the list from a slide server which maybe the same server as the synchronization server or maybe another server.

The undersigned respectfully submits that the Craig reference does not provide a recitation, teaching or suggestion that either the instructor slides or the student slides be capable of synchronous viewing as a result of “a first script and a first control and the second script and the second control” being “independent from web pages that are displayed on the first computer and the second computer” as required by each independent claim. Specifically, each of the independent claims require that the first script and first control reside on a first computer, and the second script and the second control reside on a second computer. Each of the first and second script and controls are independent of websites viewed. Craig merely teaches a single applet at the computer location to read from a pre-programmed list file that must be stored at each computer prior to the session, and provides no teaching for a first script and first control at a first computer nor does it teach a second script and second control at a second computer.

The citations recited in the Final Office Action by the Examiner as providing support for the teaching in Craig of a first script and first control and second script and second control at respective first and second computers are column 3, lines 6-29 of Craig, column 8, lines 28-51; column 10, lines 13-39; and column 14, lines 22-31. The undersigned respectfully submits that the cited locations in the Craig reference are devoid of any reference to both a first script and a first control on a first computer and second script and a second control on a second computer.

Craig merely recites a single applet at the instructor location and a single applet at the student location. Thus, the Craig reference does not, as the Examiner has stated, provide the missing element of Shelton, and thus cannot form the basis of a proper § 103 reference based on a combination of references. Craig is simply devoid of any teaching of a first script and first control at a first computer and second script and second control at a second computer. Thus, even if the combination were made of the Shelton and Craig references as proposed by the Examiner, the proposed combination would not yield the inventions as presently claimed in the independent claims recited above.

Moreover, even if Craig were to have taught the missing elements, which it is respectfully argued Craig did not, neither Shelton nor Craig contain the necessary motivation, as required by case law, for making the proposed combination of Shelton and Craig upon which the Examiner relies for rejection the independent claims. Specifically, as recited in the case law presented above, absent a specific motivation in the references themselves, combining the references to form an obviousness rejection is improper. Shelton is completely devoid of any teaching or suggestion that the scripts or controls, which Shelton admittedly discloses as necessarily embedded in the web pages to be synchronously viewed, should somehow be removed from the Shelton system as the Examiner suggests should be done utilizing the teachings of Craig. Shelton contains no teaching or suggestion as to how such a modification would actually operate in Shelton, since Shelton solely discloses synchronization using appropriately modified web pages and teaches synchronization only with respect to viewing specifically modified web pages. Craig, on the other hand teaches synchronous viewing of web pages based upon a predefined list submitted to a student computer from an instructor computer.

This list is accessed by an applet on the student computer based on instructions received from the instructor applet. The list, which is described as a file containing a list of URLs, is neither a script nor a control and thus cannot meet the recited limitation of either a first script or a first control as required by the presently pending claims. Further, it is unclear from the Examiner's rejection as to whether the Examiner is taking the position that the instructor applet and the student applet correspond to either the first script or the first control or the second script or the second control. However, in any event, since the recited claims require both a script and a control at each of the computer locations that will participate in synchronous browsing, the mere presence of an applet at each synchronous browsing location does not meet the limitation of the claims. Nor is there any teaching or suggestion that the system of Craig can be utilized in other synchronous browsing systems that utilize customized web pages wherein the scripts and/or controls are embedded in the web pages to be viewed. Thus Craig is completely devoid of any suggestion or motivation for forming the combination of Craig and Shelton as the Examiner has in the Final Rejection.

Additionally, as further evidence of the inappropriateness of the combination of Shelton and Craig, not only is Craig is devoid of any motivation for utilizing Craig to modify Shelton as the Examiner has done, but Craig explicitly distinguishes its system from other synchronous browsing applications based upon the presence of the slide list file which must be present at both the instructor location and the student location and which the student applet utilizes to obtain the next slide when the instructor desires the student to view another slide in the instructional presentation. Specifically, at column 10, lines 3-13, Craig recites:

A significant aspect of the present invention relates to list-driven nature of both Student and Instructor behavior. Rather than a simple “follow-the leader” or “master-slave” configuration in which the remote sites have no a priori knowledge of the presentation, this invention relies on a presentation as a predefined set of slides. This set may be perused at the student’s preferred pace or order, allowing full manual synchronization when desired. The presentations may also be viewed anytime in a standalone configuration, independent of any instructor or synchronization server.

It is apparent from the above quotation that the Craig system is one in which the synchronization, to the extent that it exists, is predefined by the contents of the list file which must be present in order for Craig to operate. There is simply no teaching in Craig nor Shelton as to how either of those systems should be modified to operate in accordance with the inventions as presently claimed in the aforementioned independent claims which recite a first script and first control at a first computer and second script and second control at a second computer, each of those elements being independent from web pages that are displayed on the respective first and second computer. Craig specifically teaches away from the inventions claimed which permit web page-independent synchronized browsing in a manner that Craig explicitly distinguishes from in the aforementioned block quote, wherein Craig describes the invention as significantly different from “follow-the-leader” synchronous browsing. Thus, as yet another reason for the impropriety of the proposed combination made by the Examiner in the Final Rejection, where a reference teaches away from the proposed combination, such combination may not form the proper basis of a § 103 rejection. *See e.g. Alza Corp. v. Milan Labs Inc.*, U.S. Court of Appeals the Federal Circuit, *slip op* 04-1344, December 10, 2004.

Thus, it is respectfully submitted that there are three bases for the impropriety of the proposed combination upon which the present rejection of the independent claims of the case stand rejected: 1) the Craig reference does not teach or suggest the missing elements in the Shelton reference which the Examiner concedes are missing from the Shelton reference; 2) there is no teaching or motivation in either of the references, as required by law, to support the hypothetical combination proposed by the Examiner; and 3) the Craig reference in fact explicitly teaches away from the proposed hypothetical combination.

It is respectfully submitted that for the reasons stated above the rejections to independent claims 1, 11, 23, 36, 49, 63, 73 and 74 under 35 U.S.C. § 103 should be withdrawn and early notification of such claims is earnestly requested. Further, since all claims depending from the aforementioned independent claims rely upon the same base combination of Shelton and Craig each dependent claim presently pending is allowable at least for the same reasons recited above with respect to the independent claims. Early notification of the allowability of the dependent claims is earnestly requested as well.

Conclusion

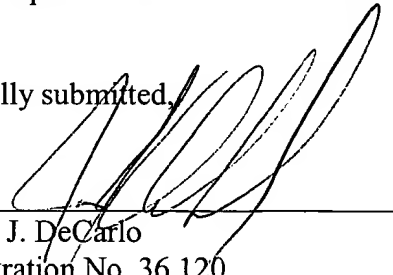
Applicant has considered the prior art of record, and respectfully submits that none of the references relied upon by the Examiner in rejecting the claims of the present application, considered alone or in any hypothetical combination (between and among each other or with the knowledge of a person of ordinary skill in the art), teach or suggest applicant's invention, as recited by the claims of the present application.

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Amdt. Dated January 12, 2005
Reply to Office Action of September 20, 2004

Applicant respectfully requests reconsideration of the present application in view of the Remarks provided herein. If the Examiner is not in a position to allow all claims as presently presented, the Examiner is urged to call the undersigned attorney at 212-806-5400. Any additional fees or charges required at this time or in the future in connection with the present application are hereby authorized to be charged to Deposit Account No. 19-4709.

Respectfully submitted,

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